



Attorney Docket No. OHS-309
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Group Art Unit: 1712
TAKAGI) Examiner: David J. Buttner
Serial No. 09/979,555)
Filed: November 26, 2001)
For: **RECLAIMED RESIN COMPOSITION**

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Official Action bearing a mail date of February 7, 2003. The one-month shortened statutory period for response is set to expire on March 7, 2003. Accordingly, this response is timely filed.

SUMMARY OF RESTRICTION REQUIREMENT
AND SPECIES ELECTION

The Restriction/Election Requirement states as follows:

This application contains claims directed to the following patentably distinct species of the claimed invention: various compositions.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

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Currently, claims 1-3 and 12-14 are generic.

SPECIES ELECTION

Applicants elect the pulverized (polycarbonate + styrenic resin + phosphoric ester) + polycarbonate species as stated in the Restriction/Election Requirement.

In the event the Restriction is not overcome, Applicants specifically preserve the right to pursue the subject matter of the un-elected species in later applications and for purposes of preserving the record for appeal.

TRAVERSAL

Applicants respectfully traverse the Examiner's Restriction Requirement because presently pending claims 1-35 share the common technical feature of a pulverized material having an aromatic polycarbonate content of 30-98% by weight, a viscosity molecular weight of 17,000 to 30,000 and a wet heat retention ratio of at least 60%.

Binding precedent states that the touchstone for requiring restriction is determining whether two or more independent and distinct inventions are claimed within the same application. MPEP §806. Restriction should never be required where the

claims of an application define the same essential characteristics of a single disclosed embodiment of the invention. MPEP §806.03. Furthermore, in a national stage application filed under 35 U.S.C. § 371 the Examiner must apply PCT Rule 13.2 in determining unity of invention. Caterpillar Tractor Co. v. Comm. Of Patents and Trademark, 650 F.Supp. 218; 231 U.S.P.Q. 590 (E.D.Va.1986); See MPEP §1850.

PCT Rule 13.2 in turn states that unity of invention exists where the claimed inventions share one or more special technical features. Id. The term special technical feature is defined as those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. Id. For example, an insecticide composition comprising a compound A (consisting of a1, a2, . . .) and a carrier share unity of invention with the claim drawn to a compound a1. See Example 16 of Annex B of Administrative Instructions under PCT.

PCT Rule 13.2 further states that a corresponding special technical feature can be shown among the members when (1) all alternatives have a common property; (2) a common structure is present; and (3) all alternatives belong to a recognized class of chemical compounds. Id. Rule 13.2 continues that a common structure is present when the alternative compounds share a

common chemical structure which occupies a large portion of the structure. Id.

In the present application, claim 1 recites a regenerated resin composition that shares the common properties of a pulverized material having an aromatic polycarbonate content of 30-98% by weight, a viscosity molecular weight of 17,000 to 30,000 and a wet heat retention ratio of at least 60%; a common structure of pulverized content in combination with a polycarbonate; and all alternatives belong to a the group of pulverized materials. Clearly, a shared common technical feature is present among the presently pending claims.

Turning to the Office Action's assertion that Applicants are required to state that the species are unpatentable (obvious) over the other, such a requirement is improper. Although the Office Action states that the generic claim (presumably claim 1) is unpatentable, that determination is premature. The sole purpose of examination is to determine patentability which should not be circumvented via a superficial examination in a Restriction Requirement.

For all these reasons, Applicants respectfully request that the Restriction be withdrawn.

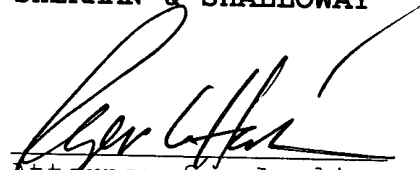
CONCLUSION

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement/election and to examine all of the claims pending in this application without any limitation as to species.

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,

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